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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,911	09/24/2003	William James Back	BAC 0007 PA/40072.12	8194

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DINSMORE & SHOHL LLP
Suite 500
One Dayton Centre
Dayton, OH 45402-2023

EXAMINER

STORMER, RUSSELL D

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/669,911

Applicant(s)

BACK, WILLIAM JAMES

Examiner

Russell D. Stormer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/5/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Claim Objections

1. Claims 1 and 15 are objected to because of the following informalities: In the last line of each of the claims, the phrase "within said wheel" is objected to as it does not clearly describe the invention. The spacers and the hub are part of the wheel as set forth by the term "comprising" in the preamble, so should not be claimed as being within the wheel. It is suggested that the phrase be changed to - -within said outer hub- - since the inner hub is supported with the outer hub by the spacers, and together with the tire, all of these components form the wheel.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 6, 7, 9, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Black.

The outer hub 28 includes grooves or recesses to receive the outer edge surfaces 23, 23A of the spacers or discs 11 and 12 and the discs support the inner hub 27 within the wheel or outer hub. The central part of the discs 21, 21A define a flat front

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surface. Recessed areas receive roller bearings. The term "decorative" is a relative term and the discs 11 and 12 could be considered decorative by their shape.

The intended use of the wheel (such as a skate wheel) is given no patentable weight since all of the structural limitations are met.

4. Claims 1, 2, 4, 5, 6, 8, 13, 15, 16, 19, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by MacBeth.

As shown in figures 6-8, 14, 18-21, 23, and 24, MacBeth discloses a wheel assembly comprising an outer rim or hub **B**, a pair of spacers or discs **A** having an outer edge **A¹** which is received in a groove in the outer hub and further supported on the hub **C²** (figure 1) in grooves formed therein. The discs would be removable by reversing the assembly process described in the patent.

With respect to claims 4, 5, 19, and 20, the cutouts are shown in figure 2 and are considered to be decorative inasmuch as they form a snowflake design.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10, 11, 12, 14, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacBeth.

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MacBeth is meets the limitations of claims 1 and 15 as set forth in paragraph 4 above.

For the inner and outer hubs to comprise aluminum would have been obvious to those of ordinary skill in the art in order to reduce the weight of the wheel.

For the spacers to be comprised of aluminum, titanium, of plastic would have been obvious to those of ordinary skill in the art to reduce the weight of the wheel.

For the spacers to have a decorative colored finish would have been obvious as such finished have long been used in the art.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references show other wheel assemblies.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell D. Stormer whose telephone number is (703) 308-3768. The examiner can normally be reached on Monday through Friday, 9 AM to 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joe Morano can be reached on (703) 308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10/8/04


RUSSELL D. STORMER
PRIMARY EXAMINER 10/8/04